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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/459,141 06/02/95 BERMAN

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ALAMEDA CA 94501

EXAMINER

WINKLER, U

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

10/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/459,141

Applicant(s)

BERMAN ET AL.

Examiner

Ulrike Winkler, Ph.D.

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-23 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-23 and 25-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's 37 CFR 1.129(a) submission after final filed on 20 August 2001 has been entered.

The Examiner and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Examiner Ulrike Winkler**, Group Art Unit 1648.

The examiner has renumbered the claims as follows. Claims 1-4 have been renumbered to the original claims numbers 10-13, claims 5-9 have been renumbered to the original claim numbers 20-24 and claims 10-15 have been renumbered to the original claim numbers 14-19. The newly added claims 16-32 have been renumbered 25-41. Applicant is advised that subsequent communication must utilize these new number designations.

Claim 24 has been canceled by the amendment filed 20 August 2001.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-23, 25-31, 40 and 41 drawn to an immunogenic composition and a method of making the immunogenic composition as it reads on herpes virus, classified in class 424, subclass 231.1.

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- II. Claims 32-38, drawn to a nucleic acid, classified in class 536, subclass 23.1.
- III. Claim 39, drawn to a method of producing a truncated membrane free polypeptide, classified in class 435, subclass 69.1.
- IV. Claims 41, drawn to an immunogenic composition comprising a truncated membrane free polypeptide derived from influenza virus, classified in class 424, subclass 206.1.
- V. Claims 41, drawn to an immunogenic composition comprising a truncated membrane free polypeptide derived from foot and mouth disease virus, classified in class 424, subclass 216.1.
- VI. Claims 41, drawn to an immunogenic composition comprising a truncated membrane free polypeptide derived from hepatitis virus, classified in class 424, subclass 206.1.
- VII. Claims 41, drawn to an immunogenic composition comprising a truncated membrane free polypeptide derived from vesicular stomatitis virus, classified in class 424, subclass 224.1.
- VIII. Claims 41, drawn to an immunogenic composition comprising a truncated membrane free polypeptide derived from rabies virus, classified in class 424, subclass 224.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I, II and IV-VIII are compositions and are distinct from Group III which is drawn to a method. Groups I, II and IV-VIII are compositions and are distinct from each other because they contain different materials. Group I comprises epitopes to herpes virus. Group IV

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comprises epitopes to influenza virus. Group V comprises epitopes to foot and mouth disease virus. Group VI comprises epitopes to hepatitis virus. Group VII comprises epitopes to vesicular stomatitis virus. Group VIII comprises epitopes to rabies virus. The epitopes from these groups are not only distinct based on the amino acid sequences they encode, they are distinct because they are from different families of viruses. The disease pathology, etiology of one virus is not the same of another virus from these groups. Group II is set apart from the other groups because it is drawn to nucleic acids, which are structurally distinct from amino acids. Group III is drawn to a method of producing a truncated membrane-free polypeptide by transfecting a host cell with a nucleic acid molecule. Therefore, the search for one group will not be coextensive with the search for the other groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294.

The examiner can normally be reached M-F, 8:30 am - 5 pm.

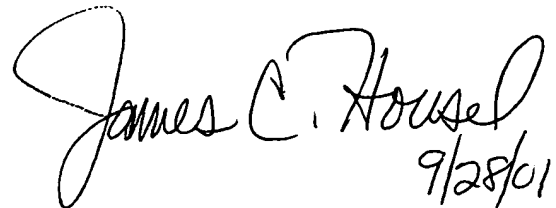
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ulrike Winkler, Ph.D.

A handwritten signature in black ink that reads "James C. Housel". To the right of the signature, the date "9/28/01" is handwritten.

JAMES HOUSEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600